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PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant : Thomas L. Bybee et al.
Serial No. : 10/626,466
Title : Specimen Carrier Transfer Apparatus
Group Art Unit : 3652

RESPONSE TO DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)

Mail Stop Petition
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

A Decision Refusing Status Under 37 CFR 1.47(a) was mailed June 22, 2004. Applicant was given two months to respond, correcting the noted deficiencies. In particular, the Petitions Attorney indicated that the petitioners had not provided: (1) sufficient proof that a copy of the complete application was sent to the non-signing inventor; and (2) an acceptable Oath or Declaration listing the non-signing joint inventors.

The second item will be addressed first, as it bears on the response to the first item. The original Petition indicated that Bybee, Murphy, Kime and Wright were non-signing joint inventors in this application. That statement was in error. Only Thomas Bybee was a non-signing joint inventor in this application. The other three were non-signing joint inventors in another application which was filed simultaneously with the instant application (that application was entitled "Two-Axis Robot for Specimen Transfer"). The specification lists all of the joint inventors on the first page. Note that Murphy, Kime and Wright are not listed.

Further evidence that Murphy Kime and Wright were not intended to be listed as inventors may be found in the copies of the letters sent to each of these three individuals. The above application was not listed, rather the above-mentioned "Two Axis Robot" invention is the only invention listed in each of these letters. It is for this reason that Murphy, Kime and Wright are not listed in the copies of the declarations that were filed with this application – because they were not inventors. Thomas Bybee is the sole non-signing joint inventor, and he is listed on the copies of the Declarations. The undersigned attorney regrets this error, and apologizes for the confusion that this has caused.

It is therefore believed that the declarations originally submitted and signed by all inventors except Thomas Bybee, are in full compliance with 37 CFR 1.63 and 1.64, since the three people omitted were not in fact, inventors.

With respect to the first item, the undersigned attorney for Petitioner sent a letter dated March 16, 2004 to the sole non-signing inventor – Thomas Bybee – via Certified Mail, Return Receipt Requested, with a copy of the complete patent application enclosed. A copy of that letter is attached hereto. The letter (with enclosed patent application) to Mr. Bybee was delivered on March 18, 2004, as indicated in the copy of the Return Receipt, attached to the copy of the letter.

The non-signing inventor was therefore given the opportunity to review the complete application and sign the Declaration. The undersigned attorney also provided ample opportunity for affirmatively indicating his refusal to sign by: (1) returning a signed statement in an enclosed self-addressed envelope stating that the inventor refuses to sign, (2) telephone the undersigned attorney to indicate a

refusal to sign, or (3) do nothing, and the absence of a response within 10 days of receipt of the documents would be presumed to be a refusal to sign. As of the date of this response (well beyond the 10 days set forth in the letter), Mr. Bybee, has not agreed to join in the application, although he has clearly had the opportunity to do so.

It is believed that this evidence explains and corrects the noted deficiencies in the original Petition, and that all of the requirements of 37 CFR 1.47(a) have been met, and it is therefore requested that this Petition be granted.

If any further information is required to expedite this process, please feel free to contact the undersigned.

Respectfully submitted,

A handwritten signature in cursive script, reading "George R. Nimmer".

George R. Nimmer
Registration No. 21,004
Attorney of Record
PO Box 252
Omaha, NE 68101-0252
(402) 393-0151



CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that the following documents, with respect to Ser. No. 10/626,466 to Bybee et al., are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on this 22nd day of July, 2004:

Response to Decision Refusing Status Under 37 CFR 1.47(a);

Copies of letter to Thomas Bybee as evidence in support of response; and

Copies of Certified Mail Receipt and corresponding Return Receipt for the letter.



Mark Frederiksen



GEORGE R. NIMMER
PATENT ATTORNEY

PO Box 252
OMAHA, NE 68101-0252
(402) 393-0151

March 16, 2004

Mr. Thomas L. Bybee
10285 Grand Ave.
Omaha, NE 68134

Certified Mail
Return Receipt Requested

Re: (1) U.S. Pat. App. Ser. No. 10/626,466 - Specimen Carrier Transfer Apparatus;
(2) U.S. Pat. App. Ser. No. 10/627,342 - Transfer and Positioning Apparatus for
Automated Conveyor System; and
(3) U.S. Pat. App. Ser. No. 10/627,415 - Two-Axis Robot for Specimen Transfer.

Dear Mr. Bybee:

I represent Lab-InterLink with respect to the filing and prosecution of the above-identified patent applications. It is my understanding that my client has contacted you in the past with a request that you sign an Oath/Declaration and an Assignment for each of the above applications. I also understand that you have refused to respond to that request.

I am writing to make one last attempt to obtain the requested signatures, or to obtain a specific refusal to sign these documents. I am enclosing a copy of each of the above-identified patent applications, a Declaration for each application, and an Assignment for each application. If, after reviewing these documents, you maintain your intent to refuse to sign, please respond by either signing the "Refusal" enclosed herewith, or contact me directly (or leave a message on my answering machine) at the number above. I am enclosing a self-addressed envelope for either the signed Declarations and Assignments or the signed "Refusals".

If I receive no response from you within 10 days of receipt of these documents, I must take this silence to be a refusal to sign any of the documents.

Sincerely,

George R. Nimmer

Cc: Lab-InterLink

Enclosures - Patent applications, Declarations, Assignments, Refusal Slips, envelopes



7003 3110 0005 4323 4378

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03/16/2004

Sent To	Thomas Bybee
Street, Apt. No., or PO Box No.	10285 Grand Ave.
City, State, ZIP+4	Omaha, NE 68134

PS Form 3800, June 2002 See Reverse for Instructions

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- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

Thomas L. Bybee
10285 Grand Ave
Omaha, NE 68134

COMPLETE THIS SECTION ON DELIVERYA. Signature
X *Thomas Bybee* ☐ Agent ☒ AddresseeB. Received by (Printed Name) *Thomas Bybee* C. Date of Delivery *3-18-04*D. Is delivery address different from item 1? ☐ Yes
If YES, enter delivery address below: ☐ No3. Service Type
☒ Certified Mail ☐ Express Mail
☐ Registered ☐ Return Receipt for Merchandise
☐ Insured Mail ☐ C.O.D.4. Restricted Delivery? (Extra Fee) ☐ Yes

2. Article Number (Transfer from sel) 7003 3110 0005 4323 4378

PS Form 3811, August 2001

Domestic Return Receipt

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